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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,421	01/07/2002	Kunio Okada	8010-1001	4679
466	7590	10/29/2004	EXAMINER	
YOUNG & THOMPSON			BECKER, DREW E	
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ARLINGTON, VA 22202			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/036,421	OKADA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Drew E Becker	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 and 13-29 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 13-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

1. Newly submitted claims 21-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the product of claims 1-9 and 13-20 can be used in another and materially different process from that of method claims 21-29, for instance as infant formula.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Amendment***

2. The declaration filed under 37 CFR 1.132 filed August 13, 2004 is insufficient to overcome the rejection of claims 1-9 and 13-20 based upon Euber, and also in view of Inoue et al, as set forth in the last Office action because: the rejection of claims 1-3 and 5-9 was under 35 U.S.C. 102(e) and therefore cannot be overcome by a declaration alone. Furthermore, it include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. Also, it refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus,

there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

3. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1, 4, and 19 recite "(B) at least one substance selected from the group consisting of (a) at least one compound selected from... and (b) at least one substance selected from...". It is not clear whether the emulsion requires both (a) and (b), or simply one of them.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 5-9, 13, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Euber [Pat. No. 6,077,558].

Euber teaches an emulsion comprising fats and oils (column 3, line 11), monoglycerides (column 4, line 19), proteins (column 2, line 47), amino acids (column 2, line 49), carageenan as a stabilizer (column 4, line 15), alkali salts such as sodium citrate (column 11, line 40), 0.9 parts monoglyceride per 100 parts oil (column 6, Table 1), 66.8 parts protein per 100 parts oil (column 6, Table 1), 1.3 parts amino acid per 100 parts oil (column 6, Table 1), 2.9 parts carageenan per 100 parts oil (column 6, Table 1), 4.8 parts alkali salts per 100 parts oil (column 6, Table 1), 33.3% solids (column 6, Table 1), the fats and oils including soy, coconut, and palm oil (column 3, line 24), diacetyl tartaric acid esters (Table 2), sucrose esters (Table 2), diglycerides (Table 2), lecithin (Table 2), and casein, whey, and soy hydrolysate (column 2, line 56).

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Euber in view of Inoue et al [Pat. No. 5,972,367].

Euber teaches the above mentioned components. Euber does not recite L-arginine, L-lysine, L-histidine, L-proline, L-glutamate, or salts thereof. Inoue et al teach an emulsion comprising L-lysine, L-arginine, L-histidine, and L-proline (column 3, lines 40-50). It would have been obvious to one of ordinary skill in the art to incorporate the specific amino acids of Inoue et al into the invention of Euber since both are directed to emulsions, since Euber already required an amino acid mixture (column 6, line 39), and since these amino acids were commonly used in emulsions as shown by Inoue et al (column 3, lines 40-50).

11. Claims 14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Euber as applied above, in view of Nakayama et al [Pat. No. 6,287,623].

Euber teaches the above mentioned concepts. Euber does not specifically recite the use of tallow. Nakayama et al teach an emulsion comprising tallow (column 3, line 49). It would have been obvious to one of ordinary skill in the art to incorporate the tallow of Nakayama et al into the invention of Euber since both are directed to food emulsions for beverages, since Euber already included any FDA approved natural or synthetic oil (column 3, line 11), since Nakayama et al teach using tallow in combination with plant oils (column 3, line 49), and since tallow was a commonly used fat in beverage emulsions as shown by Nakayama et al.

#### *Response to Arguments*

12. Applicant's arguments filed August 3, 2004 have been fully considered but they are not persuasive.

Applicant argues that the amino acids of Euber were "free" and not "basic".

However, it is not clear what applicant's definition of "basic" is since one of the claimed "basic" amino acids (proline) is in fact a hydrophobic amino acid. Therefore, the hydrophobic amino acids of Euber (tryptophan and tyrosine) could also be considered "basic". See "Food Chemistry" pages 322-326. Furthermore, the term "free amino acids" is defined by Inoue et al (column 3, line 49) as being the non-attached form of the amino acid, therefore encompassing the subset of "basic amino acids".

Applicant argues that Euber required the use of OSA starch. However, applicant's claims do not exclude the use of OSA starch.

In response to applicant's argument that Euber does not mention processed meat, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding the declaration, see paragraph 2 above.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Thur. 8am-5pm and every other Fri. 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Drew E Becker  
Primary Examiner  
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10/28/01